

Appl. No. 09/655,402
Amdt. dated September 10, 2003
Reply to Office Action of June 11, 2003

Docket No.: K-214

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 1-20 are pending in the application.

The foregoing claim amendments were made to correct formalities such as grammatical errors and to place the present Application in better form for examination. The foregoing amendments do not narrow the scope of the originally presented claims.

35 U.S.C. § 102 & 103 Rejections

Claims 1-20 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Bojeryd (U.S. Patent No. 5,946,622) in view of Baum et al. (U.S. Patent No. 6,510,319, "Baum") and Weaver Jr. et al. (U.S. Patent No. 5,917,811, "Weaver"). Applicant respectfully traverses each of these rejections for at least the following reasons.

Regarding claims 1 and 11, the Office Action alleges that the Bojeryd reference teaches a macrocell and picocell and the ability to hand off between the two systems. The Office Action acknowledges that the Bojeryd reference does not teach "performing a power control such that a transmission power level of said mobile station is not lowered, if said mobile station is determined to be within said soft handoff region and if a soft handoff of said mobile station is required." However, the Office Action alleges that Baum teaches this feature and that it would have been obvious to combine these references to arrive at

Appl. No. 09/655,402
Amdt. dated September 10, 2003
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Docket No.: K-214

Applicant's claimed combinations. Applicant respectfully disagrees both with the Office Action's characterization of the teachings of these references and the proposed combination of these references, for at least the following reasons.

For example, the Office Action cites the title and abstract of Baum and interprets these as reading on "the transmission power is not lowered" (page 2 of Office Action dated June 11, 2003). In contrast to the Office Action's interpretation the abstract of Baum discloses the following (with emphasis added):

Performance of a wireless telecommunications systems is enhanced by communication of an actual applied forward link gain and, if necessary, an overload indicator from base stations participating in a soft handoff. Subsequently, a power control system within a selection/distribution unit determines a **forward link gain acceptable to all base stations** involved in a soft handoff call.

As clearly stated in the abstract quote above, Baum is concerned with a "forward link gain acceptable to all base stations". Accordingly, Baum is concerned with adjusting the gain of the base station and is completely silent on the mobile terminal transmission power level, i.e., "performing a power control such that a transmission power level of said mobile station is not lowered", as alleged by the Office Action.

Further, Baum explicitly teaches to lower the gain of the base station. This is expressly taught in column 2, lines 21-29 of Baum, which follows (with emphasis added).

More particularly, when an overload status is attained by a base station, it informs the SDU of the actual value of the power gain level applied and its power overload status. Once the overload status is detected, no further gain increases by the SDU are allowed until the power overload condition is

Appl. No. 09/655,402
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Docket No.: K-214

retracted. **Gain decreases, however, are allowed.** That is, the subsequent **gain values can be less than or equal** to the value returned with the most recent response indicating overload.

As expressly stated in the above-referenced section, Baum teaches to decrease the gain of the forward link. Applicant fails to understand how this can be interpreted by the Office Action as reading on "the transmission power is not lowered" (page 2 of Office Action dated June 11, 2003). Applicant respectfully submits that the Office Action's interpretation of Baum is in direct contradiction to Baum's express teachings. Therefore, the Baum reference as applied cannot teach the features alleged by the Office Action.

Additionally, regarding claim 11, the Office Action discusses "EHDM" and "HCM". However, Applicant respectfully submits that claim 11 does not contain the acronyms "EHDM" and "HCM". Applicant assumes that the Office Action is referring to extended handoff direction message and handoff complete message, respectively. However, Applicant is not certain of the Office Action's interpretation of these terms in regard to the pending claims and respectfully requests clarification if these acronyms are used in future actions. Also, the Office Action takes Official Notice regarding "EHDM" and "HCM". The Applicant traverses this rejection because there is no support in the record for the conclusion that the identified features are "old and well known." In accordance with MPEP § 2144.03, the Examiner must cite a reference in support of his position.

Further regarding claim 11, the Examiner relies on Weaver to cure the additional deficiencies of the Bojeryd and Baum references failing to teach "setting a reverse link

Appl. No. 09/655,402
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Docket No.: K-214

coverage of said picocell greater than a forward link coverage of said picocell..." (page 2 of Office Action dated June 11, 2003). However, Weaver teaches, as noted by the Office Action, "a base station which balances a forward link coverage area to a reverse link coverage area" (page 2, Office Action dated June 11, 2003). Once again, Applicant respectfully submits that the Office Action has ignored the express teaching of a reference to "interpret" a completely contradictory teaching. In this case, in direct contradiction to the admitted teaching of Weaver, the Office Action alleges that Weaver teaches a reverse link coverage area greater than a forward link coverage area. Accordingly, Applicant respectfully submits that the Weaver reference as applied cannot teach the features alleged by the Office Action.

As stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Neither Bojeryd, Baum, Weaver nor the combination of these references discloses the features of Applicant's claimed combinations as noted above. Therefore, these references do not render Applicant's claimed combinations obvious as alleged by the Office Action.

Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303

Appl. No. 09/655,402
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Docket No.: K-214

(Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). As confirmed in MPEP § 2145, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). Clearly, in applying the Baum and Weaver references, the Office Action completely disregards the teachings of these references that expressly teach away from the claimed features. Accordingly, these references do not render Applicant's claimed combinations obvious as alleged by the Office Action.

Further, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the systems of Bojeryd, Baum, and Weaver to arrive at Applicant's claimed combinations absent impermissible hindsight reference to Applicant's specification.

Remaining independent claim 20 recites related subject matter to the above-identified independent claims, and is therefore allowable for reasons similar to those given above.

Further, the dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

For at least the above-stated reasons, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections to claims 1-20.

Appl. No. 09/655,402
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Docket No.: K-214

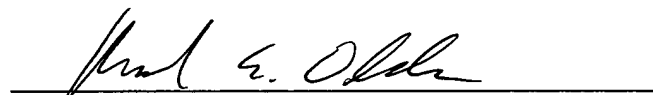
CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the Mark E. Olds, to conduct an interview in an effort to expedite prosecution in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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